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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,228	09/30/2003	Tetsuya Wakamori	XA-9098B	1589
181	7590	10/11/2005	EXAMINER	
MILES & STOCKBRIDGE PC 1751 PINNACLE DRIVE SUITE 500 MCLEAN, VA 22102-3833			ROSS, DANA	
			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 10/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/673,228	Applicant(s) WAKAMORI, TETSUYA	
	Examiner Dana Ross	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-18 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14, 16 and 17 is/are rejected.
- 7) ☒ Claim(s) 15 and 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/296,294.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The objection to the drawing is withdrawn due to Applicant's amendment dated 31 August 2005.

Claim Rejections - 35 USC § 112

2. The rejection of the claims under 35 USC 112 is withdrawn due to Applicant's amendment dated 31 August 2005.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 14, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Applicant's Admitted Prior Art (AAPA).

Page 1, lines 15-22 and Figure 8 of AAPA discloses it is well known in the art to have a punching means for segments (page 1), holding and pushing means for the segments (fig 8), and means for pressing and adhering segments with gaps which constitute the oil grooves (page 1).

As is shown in AAPA (figure 8), plural segments 3 are stacked and are adhered to the core plate 1 with oil grooves 4 creating "gaps" between the segments. Figure 8 shows a plurality of oil grooves, which would include first and second "plurality of oil grooves.

It is noted that the limitation of the oil grooves formed by plastic working (claim 14), pressing (claim 16) or cutting (claim 17) is directed towards a *method* of forming generic “oil grooves”.

Concerning the method for making the grooves, plastic working, pressing (claim 14) or cutting (claim 17), the method of forming is not germane to the issue of patentability of the apparatus itself since under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claim, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed the device will inherently perform the claimed process (See MPEP Section 2112.01). In this instance, the structure of the gaps and grooves of the friction plate as taught by AAPA meets the structural limitations of the claimed friction plate of independent claims 14 and 17.

It is noted that Applicant claims two separate “plurality of oil grooves”, a first and a second. Though the claimed structure both the first and second plurality of oil grooves can be found in figure 8 of Applicant’s disclosure, in the event that Applicant does not agree that the first and second plurality of oil grooves are the same, Applicant is referred to the below 35 USC 103 claim rejection.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 14, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of US Pat. No. 3,897,860 (Borck et al., hereafter '860).

Page 1, lines 15-22 and Figure 8 of AAPA discloses it is well known in the art to have a punching means for segments (page 1), holding and pushing means for the segments (fig 8), and means for pressing and adhering segments with gaps which constitute the oil grooves (page 1).

As is shown in AAPA (figure 8), plural segments 3 are stacked and are adhered to the core plate 1 with oil grooves 4 creating "gaps" between the segments. Figure 8 shows a plurality of oil grooves, which would include first and second "plurality of oil grooves.

It is noted that the limitation of the oil grooves formed by plastic working (claim 14), pressing (claim 16) or cutting (claim 17) is directed towards a *method* of forming generic "oil grooves".

AAPA (figure 8) teaches the same "oil groove" gap between the friction material segments. AAPA does not disclose a distinction between two pluralities of oil grooves.

'860 teaches it is well known in the art to have a plurality of grooves, or gaps, as is shown in figure 2 with friction plates 48 separated by groove 25 (fluid passages) and radial grooves 49 (col. 3, lines 30-37, for example).

Concerning the method for making the grooves, plastic working, pressing (claim 14) or cutting (claim 17), the method of forming is not germane to the issue of patentability of the apparatus itself since under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claim, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed the device will inherently perform the claimed process (See MPEP Section 2112.01). In this instance, the structure of the gaps and grooves of the friction plate as taught by AAPA meets the structural limitations of the claimed friction plate of independent claims 14 and 17.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus for producing a friction plate as taught by AAPA to include the oil grooves and gaps on the friction plate as taught by '860 for the purpose of providing a friction plate which minimizes turbulence in the oil so that its flow is controlled, frothing prevented and less heat is generated (see '860 abstract, for example).

Allowable Subject Matter

7. Claims 15 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art neither anticipates nor renders obvious an apparatus for producing friction plates as claimed in dependent claims 15 or 18, with the combination of limitations of the independent claims, specifically wherein the apparatus creates first and second pluralities of oil

grooves as distinctly claims that are parallel to a supply direction of the friction material segments.

The closest prior art found is AAPA and '860, as is discussed in detail in the above and previous office actions.

Neither AAPA nor '860 teach having the apparatus such that the first and second pluralities of oil grooves are parallel to the supply direction of the friction material segments. Both AAPA and '860 teaches non-parallel grooves to the supply direction of the friction material segments. Therefore the prior art does not anticipate the claimed invention.

Furthermore, there is no prior art that would render obvious the claimed invention, either alone or in combination with the prior art, and no motivation found to modify the prior art to obtain the claimed invention.

Response to Arguments

8. Applicant's arguments with respect to claims 14-18 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dana Ross whose telephone number is 571-272-4480. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



dmr



BOYER D. ASHLEY
PRIMARY EXAMINER